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Technology Center 2100

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805 Third Avenue
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In re Application of: Samuel Sergio
Tenenbaum
Application No. 09/922,232
Filed: August 3, 2001
For: COMPUTERIZED ADVERTISING
METHOD AND SYSTEM

DECISION ON PETITION TO MAKE
SPECIAL UNDER 37 C.F.R. §1.102(d) AND
MPEP §708.02(II) AND 37 C.F.R. §1.496(b)
IN CONJUNCTION WITH MPEP §1893.03

This is a decision on the petition, filed November 30, 2001, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, and under 37 C.F.R. §1.496(b) in conjunction with M.P.E.P. §1893.03.

I. Infringement

A grantable petition under 37 C.F.R. §1.102(d), and M.P.E.P. §708.02, Section II, must be accompanied by payment of the fee under 37 C.F.R. §1.117(h) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the prior art. Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims.

Applicant's petition is deficient in that it has **not been expressly stated that a rigid comparison has been made** between the infringing device, product, or method with the claims of the application and that some of the claims are **unquestionably** infringed. It should also be noted that though it may be construed that a careful and thorough search has taken place due to the IPER, this should be stated outright in the petition. Furthermore, the applicant has **failed to provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims.**

II. Continuation

37 C.F.R. §1.496(b) states:

A national stage application filed under 35 U.S.C. 371 may have paid therein the basic national fee as set forth in §1.492(a)(4) if it contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability. Such national stage applications in which the basic national fee as set forth in §1.492(a)(4) has been paid may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications in which the basic national fee as set forth in §1.492(a)(4) has been paid will be taken up out of order.

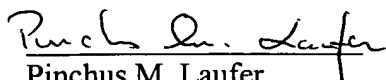
M.P.E.P. §1893.03 states:

An international application which enters the national stage will be forwarded to the appropriate Technology Center (TC) for examination in turn based on the 35 U.S.C. 371(c) date of the application. As set forth in 37 CFR 1.496(b), if an application includes only claims which have been indicated in an IPER prepared by the USPTO to satisfy the criteria of PCT article 33(1)-(4), the application qualifies for the reduced basic national fee set forth in 37 CR 1.492(a)(4). Applications in which the reduced basic national fee has been paid will be taken up out of order by examiners.

Though the applicant has provided an IPER satisfying the criteria of PCT article 33(1)-(4) as to novelty, inventive step, and industrial applicability, it should be noted that the **application has not been filed as a continuation application under 37 CFR 371.** Furthermore, the **claims of the application are not identical in scope** to those that were considered in the IPER. Thus, the application does not meet the requirements to be taken up out of order as described in 37 CFR §1.496(b) and M.P.E.P. §1893.03.

Accordingly, the petition is **DISMISSED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

If the petitioner desires further review of this decision, applicant should consider filing a Request for Reconsideration within 2 months of the mailing date of this decision.



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